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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------|------------------------|
| 10/761,175   | 01/20/2004  | Sau Chu Chan         | CA920030066US1             | 2047                   |
| 58139  | 7590        | 02/25/2009           |                            |                        |
| IBM CORP. (WSM)<br>c/o WINSTEAD SECHREST & MINICK P.C.<br>P.O. BOX 50784<br>DALLAS, TX 75201 |             |                      | EXAMINER<br>GARG, YOGESH C |                        |
|  |             |                      | ART UNIT<br>3625           | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>02/25/2009    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/761,175 | <b>Applicant(s)</b><br>CHAN ET AL. |  |
|                              | <b>Examiner</b><br>Yogesh C. Garg    | <b>Art Unit</b><br>3625            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 12/18/2008 has been entered.

Claims 1, 9 and 12 have been currently amended and they are the only claims pending for examination. Claims 2-8, 10-11 and 13-20 were previously cancelled.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 9 and 12 have been considered but the arguments regarding prior art rejection are moot in view of the new ground(s) of rejection necessitated due to current amendments.

Further, the examiner does not agree that during the interview conducted on November 17 he agreed to allow the claims but instead he indicated that he would consider the amendments fully and would be required to do a new search. As per the new search claims 1, 9 and 12 are unpatentable over Dan et al. (US 20020138370 A1 published on Sep 26, 2002), hereinafter Dan, in view of Habiby et al. (US 20030033215 A1 published on 2/13/2003), hereinafter Habiby.

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In view of the current amendments made to claim 9 previous rejection under 35 USC 101 is withdrawn.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: based on received specific request for quotation creating a partition of a targeted product set, from the non targeted product sets for a corresponding targeted customer. At present the claims do not recite the critical connecting relationship between the specific requests received and the step of creating a partition of a targeted product set for a corresponding targeted customer. With the currently recited limitations the step of creating a partition of a targeted product set does not depend upon receiving specific request and which is not true as per the applicant's specification.

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5. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the

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applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (US 20020138370 A1 published on Sep 26, 2002), hereinafter Dan, in view of Habiby et al. (US 20030033215 A1), hereafter Habiby.

Regarding claim1, Dan discloses a computer implemented system and method comprising a memory unit storing a computer program offering a plurality of products for a vendor to prospective customers and a processor coupled to said memory unit wherein said processor , responsive to said computer program (see at least figs 3 and 4 which show the required server comprising a memory unit, processor unit and software ), comprises:

circuitry configured to receive a specific request for quotation (see at least paragraphs 20 , 37 and claims 1, 9, 12,23,25. Server is configured to receive requests from clients for selected items to create a customized catalog. Since the items selected in the request are used to create customized catalogs the requests correspond to specific requests for specific items);

circuitry configured to create a partition of a targeted product set for a corresponding targeted customer (see at least paragraphs 20 , 37 and claims 1, 9, 12,23,25. Server is configured to receive requests from clients for selected items to create a customized catalog. The created customized catalog for each

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respective customer corresponds to the claimed targeted product set which partitions the other products available in the base/publicly available catalog );

circuitry configured to provide said targeted product set for said targeted customer and present views of products from targeted sets to respective targeted customers (see at least paragraph 37, "*...Further, customized catalog 414 may also be sent to a user for use locally by the user.....*");

circuitry configured to provide a non targeted product set available to targeted customers and present views of products from non-targeted sets to respective targeted customers (see at least paragraph 37, "*...In these examples, a user may "meta-shop" or select items from catalog 410, which is a base, general, or public catalog. .... Targeted customers creating customized catalogs can always access and view non targeted product sets that is items in base/public catalogs*");;

circuitry configured to make said non targeted product set available to public customers and present views of products from non-targeted sets to public customers (see at least paragraph 37, "*...In these examples, a user may "meta-shop" or select items from catalog 410, which is a base, general, or public catalog.*

*..... Public customers can always access and view non targeted product sets that is items in base/public catalogs ); and*

circuitry configured to determine each said targeted product set in accordance with the terms and conditions of a trading agreement between said vendor and a respective targeted customer (see at least paragraph 37, "*....Upon a request from a user, the items placed in the shopping cart through these selections are used to generate customized catalog 414. Various terms and conditions also may be associated*

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with customized catalog 414. Further, customized catalog 414 may also be sent to a user for use locally by the user. ).

Dan does not teach explicitly circuitry configured to provide a master targeted product set of selected products that is not to be available to non targeted customers, wherein said master targeted product set is a compilation of targeted product sets for corresponding targeted customers and circuitry configured to determine said master targeted product set in accordance with terms and conditions of trading agreements between said vendor and said targeted customers. However, it is well-known to create master files in a database system to store critical subject/specific matter/data/information including data related to targeted products for a customer as shown in Habiby (see at least paragraphs 46,48 and 64). In view of Habiby, it would be obvious to one of an ordinary skilled in the art to modify Dan and create a master file/set to store he created all the targeted product sets for different customers **because it would narrow down the search for said subject matter/data/information/targeted products and would make the search for targeted products faster and convenient** . As regards determining that said master targeted product set in accordance with terms and conditions of trading agreements between said vendor and said targeted customers, Dan teaches this aspect (see at least paragraph 37, "...Upon a request from a user, the items placed in the shopping cart through these selections are used to generate customized catalog 414. Various terms and conditions also may be associated with customized catalog 414. Further, customized catalog 414 may also be sent to a user for use locally by the user. ).



Regarding claims 9 and 12, their limitations are similar to the limitations of claim 1 and therefore they are analyzed and rejected on the basis of same rationale as set forth for claim 1 above.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Song et al. (US 20030083959 A1, see at least Abstract, paragraph 8, and claims 1, 6) teaches a system and method for creating a customized product catalog in response to a request having user specified attributes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg  
Primary Examiner  
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